

REMARKS

This Application has been carefully reviewed in light of the Office Action dated June 18, 2007 ("Office Action"). In the Office Action, Claims 1-3, 5-8, 10-30, 32, 33, and 35-37 are pending and rejected. Applicants respectfully request reconsideration and favorable action in this case.

Section 103 Rejections

The Office Action rejects Claims 1-6, 10-16, and 35-36 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,799,273 issued to Mitchell et al. ("*Mitchell*") in view of U.S. Patent No. 6,240,391 issued to Ball et al. ("*Ball*"). The *Office Action* rejects Claims 7-8, 17, 30, and 32-33 under 35 U.S.C. § 103(a) as being unpatentable over *Mitchell* in view of *Ball* and further in view of U.S. Patent No. 6,068,487 issued to Dionne ("*Dionne*") and U.S. Patent No. 6,424,357 issued to Frulla et al. ("*Frulla*"). The *Office Action* rejects Claims 18-29 and 37 under 35 U.S.C. § 103(a) as being unpatentable over *Mitchell* in view of *Dionne* and *Frulla*. For the reasons described below, Applicants respectfully request reconsideration and allowance of Claims 1-8, 10-33, and 35-37.

A. The Proposed *Mitchell-Ball* Combination is Improper

Applicants respectfully submit that the proposed *Mitchell-Ball* combination, as applied to Applicants' Claims 1-6, 10-16, and 35-36 is improper for at least the following reasons.

Applicants respectfully contend that the Examiner has not presented a legally sufficient argument demonstrating a motivation to combine *Mitchell* with *Ball*. According to the M.P.E.P., in order "[t]o establish a prima facie case of obviousness . . . there must be some suggestion or motivation either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings." See §2143. Notably absent from this list is an allowance for an Examiner's conjectured assertion as to the motivation to combine reference teachings. A quote from the M.P.E.P. is directed specifically to this point: "[t]he examiner and the board asserted that it would have been within the skill of the art to substitute one type of detector for another in the system of the primary reference, however the court found there was **no support or explanation** of this conclusion and reversed." See §2143.01 (I) (emphasis added). Thus, "the proper inquiry

is whether there is something in the prior art as a whole to suggest the *desirability* . . . of making the combination.” *Id.* (internal quotations omitted) (emphasis original). “The mere fact that the references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the **desirability** of the combination.” See §2143.01 (III) (emphasis original and added). Most recently, this requirement has been reaffirmed in an official USPTO memorandum dated May 3, 2007 wherein the Deputy Commissioner for Patent Operations pointed to sections of *KSR v. Teleflex*, which recite, “it will be necessary . . . to determine whether there was an **apparent reason** to combine the known elements in the fashion claimed by the patent at issue.”¹

As applied to the present application, the Office Action has failed to meet this burden because the Examiner has not shown “something in the prior art as a whole to suggest the *desirability*” of combining *Mitchell* with *Ball*, but rather seems to rely on a conjectured assertion that “the references can be combined” without regard to the “desirability of the combination.” This directly conflicts with the M.P.E.P. requirements for supporting a motivation to combine references. Specifically, the Examiner speculates with regard to independent Claims 1, 10, and 35 that “[i]t would have been obvious to one of ordinary skill at the time of the invention to modify the system [of] *Mitchell* to provide the linked audio media stream packets and text data for transmission to a user of a telecommunications device, so as to generate structured voice mail messages so as to provide the voice mail recipient the ability to access any audio, text, video, or multi-media type message that has been stored.” (*Office Action*, Pages 2 and 6). However, this bald assertion does not meet the requirements of the M.P.E.P. The Examiner did not provide “support or explanation” for why one would be specifically motivated to combine the proofreading interface used to edit dictated text as disclosed in *Mitchell* with the method for assembling and presenting voicemail messages as disclosed in *Ball*.

Furthermore, one of ordinary skill in the art would not have recognized at the time of Applicants’ invention a *desirability* of combining the technology of *Mitchell* with the method for assembling and presenting voicemail messages as disclosed in *Ball* since *Mitchell* does not at all relate to voicemail messages. Applicants are confused as to how the *Mitchell* disclosure,

¹ *KSR Int'l. Co v. Teleflex Inc.*, No. 04-1350 (April 30, 2007) (emphasis added).

providing a “proofreading interface used to edit dictated text” relates to the Examiner’s asserted motivation of “so as to provide the voice mail recipient the ability to access any audio, text, video, or multi-media type message that has been stored.” The motivation provided by the Examiner does not suggest the proposed combination of *Mitchell* and *Ball*. It is settled that “[i]t is essential to view the invention as a whole, taking each element into account as well as the advantages, properties, utilities, and results of the invention.” *In re Chupp*, 816 F.2d 643, 2 U.S.P.Q.2d 1437 (Fed. Cir. 1987). As discussed above, the very principle and purpose of the system disclosed in *Mitchell* is the conversion of dictated speech to text. Conversely, the very principle and purpose of the system disclosed in *Ball* is the conversion of text to speech. Accordingly, the two types of systems do not share a common objective and do not even deal with the same types of problems or implement the same types of solutions to those problems. In light of this apparent logical disconnect, Applicants contend that the Examiner has failed to show any “support or explanation” for the asserted motivation to combine references beyond the Examiner’s own conjecture. These facts provide further evidence that one of ordinary skill in the art at the time of Applicants’ invention would have considered the references as relating to different fields of invention and would not made the proposed combination. Applicants respectfully submit that the Examiner’s attempt to modify or combine *Mitchell* with *Ball* appears to constitute the type of impermissible hindsight reconstruction of Applicants’ claims, using Applicants’ claims as a blueprint, that is specifically prohibited by the M.P.E.P. and governing Federal Circuit cases.

Applicants therefore further request that the rejections of Claims 1-6, 10-16, and 35-36 be withdrawn for want of a *prima facie* showing of obviousness as defined by the M.P.E.P. and for the various other reasons described above.

B. The Proposed *Mitchell-Ball-Dionne-Frulla* Combination is Improper

Applicants respectfully submit that the proposed *Mitchell-Ball-Dionne-Frulla* combination, as applied to Applicants’ Claims 7-8, 17, 30, and 32-33, is improper for at least the following reasons.

First, Applicants respectfully submit that the *Office Action* does not present a legally sufficient argument demonstrating a motivation to combine *Mitchell* and *Ball* in the *Mitchell-*

Ball-Dionne-Frulla combination. Specifically, the *Office Action* has failed to meet this burden because the Examiner has not shown “something in the prior art as a whole to suggest the *desirability*” of combining *Mitchell* with *Ball*, but rather seems to rely on a conjectured assertion that “the references can be combined” without regard to the “desirability of the combination.” Again, with respect to each claim, the Examiner speculates that “[i]t would have been obvious to one of ordinary skill at the time of the invention to modify the system [of] *Mitchell* to provide the linked audio media stream packets and text data for transmission to a user of a telecommunications device, so as to generate structured voice mail messages so as to provide the voice mail recipient the ability to access any audio, text, video, or multi-media type message that has been stored.” (*Office Action*, Pages 8). However, Applicants demonstrated above with respect to independent Claims 1, 10, and 35 that the stated motivation merely amounts to a conjectured assertion that “the references can be combined” without regard to the “desirability of the combination.” Additionally, Applicants have shown above that one of ordinary skill in the art at the time of Applicants’ invention would not have been motivated to make the proposed combination. Accordingly, for the same reasons that the proposed *Mitchell-Ball* combination is improper with regard to independent Claims 1, 10, and 35, the proposed *Mitchell-Ball-Dionne-Frulla* combination is also improper with respect to Claims 7-8, 17, 30, and 32-33.

Second, Applicants respectfully submit that the *Office Action* does not present a legally sufficient argument demonstrating a motivation to further combine the teachings of *Dionne* with those of *Mitchell* in the proposed *Mitchell-Ball-Dionne-Frulla* combination. With respect to each of Claims 7-8, 17, 30, and 32-33, the Examiner speculates that “[i]t would have been obvious to one of ordinary skill at the time of the invention to modify the system of *Mitchell* to provide the spelling of words in the text, to aid in the editing of recognized text and in the correcting of recognition errors, for the purpose of assisting individuals with visual impairments with editing of text.” (*Office Action*, page 8). Again, Applicants submit that the *Office Action* has failed to fulfill M.P.E.P. requirements for supporting a motivation to combine references because the Examiner has not shown “something in the prior art as a whole to suggest the *desirability*” of combining *Mitchell* with *Dionne*, but rather seems to rely on a conjectured assertion that “the references can be combined” without regard to the “desirability of the combination.” The Examiner’s bald assertion does not provide “support or explanation” for

why one would be specifically motivated to combine the proofreading interface used to edit dictated text as disclosed in *Mitchell* with speller reading system disclosed in *Dionne*.

Furthermore, one of ordinary skill in the art would not have recognized at the time of Applicants' invention a *desirability* of combining the proofreading interface used to edit dictated text as disclosed in *Mitchell* with the speller reading system disclosed in *Dionne*. *Mitchell* specifically discloses that during the word processing process "a user can position the cursor in the text on the display using the keyboard 2 or the pointing device 3." (*Mitchell*, Column 9, lines 13-16). The user can then "delete and/or insert text by, for example, typing using a keyboard or inserting text from elsewhere using conventional word processing techniques." (*Mitchell*, Column 9, lines 16-19). If the user believes that a word has been incorrectly recognized, "the user selects a word which is believed to be incorrectly recognized" and the "word is then highlighted on the display." Thus, the very principle of *Mitchell* is to display text to a user for word processing. Applicants are confused then as to how or why one of ordinary skill at the time of Applicants' invention would be motivated to combine the "proofreading interface used to edit dictated text" disclosed in *Mitchell* since with the audio speller of *Dionne* "for the purpose of assisting individuals with visual impairments with editing of text." The M.P.E.P. clearly states that "[i]f a proposed modification would render prior art unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. M.P.E.P. § 2143.01; See *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984). The system of *Mitchell* clearly requires a display to be functional for its intended purpose (i.e., editing dictated text using conventional word processing techniques). Applicants can identify no reason for audibly spelling a word when that very word is presented to the user on the display of *Mitchell*. Altering the system of *Mitchell* "for the purpose of assisting individuals with visual impairments," as suggested by the Examiner, would require substantial modification to the display-centered system of *Mitchell*. Additionally, since omitting the display from the system of *Mitchell* would render the system of *Mitchell* unsatisfactory for its intended purpose (i.e., editing dictated text using conventional word processing techniques, Applicants respectfully submits that the proposed modification of *Mitchell* to incorporate the speller of *Dionne* is improper.

Third, Applicants respectfully submit that a rejection of Applicants' claims under the proposed *Mitchell-Ball-Dionne-Frulla* combination appears to constitute the type of impermissible hindsight reconstruction of Applicants' claims, using Applicants' claims as a blueprint, that is specifically prohibited by the M.P.E.P. and governing Federal Circuit cases. Applicants note that with respect to certain independent claims the Examiner relies upon *Mitchell* for disclosure of retrieving a text file, storing an audio file, and storing a file map. The Examiner then relies upon *Ball* for disclosure of test to speech conversion and for transmission of the audio file to a telecommunications device. The Examiner relies upon *Dionne* for disclosure of a speller but on *Frulla* for disclosure of a voice command from a user. Even if each of these references disclose what the Examiner purports they disclose (which Applicants do not admit), a rejection of Applicants' claims under the proposed *Mitchell-Ball-Dionne-Frulla* combination can only result from the piecing together of disjointed portions of unrelated references to reconstruct Applicants' claims. Such a piecemeal rejection of Applicants' claims fail to give credence to each element of Appellants' claims and to the overall combination of features recited in the claims. The very fact that three non-analogous references must be compiled and disjointed portions of those references combined to meet the requirements of Applicants' claim limitations provides further evidence that one of ordinary skill in the art at the time of Applicants' invention would not have been motivated to make the proposed combination.

Applicants therefore further request that the rejections of the present claims be withdrawn for want of a *prima facie* showing of obviousness as defined by the M.P.E.P. and for the various other reasons described above.

C. Claims 18-29 and 37 are Allowable

Applicants respectfully submit that the proposed *Mitchell-Dionne-Frulla* combination, as applied to Applicants' Claims 18-29 and 37, is improper for at least the following reasons.

First, Applicants respectfully submit that the *Office Action* does not present a legally sufficient argument demonstrating a motivation to combine *Mitchell* and *Dionne* in the *Mitchell-Dionne-Frulla* combination. Specifically, the *Office Action* has failed to meet this burden because the Examiner has not shown "something in the prior art as a whole to suggest

the *desirability*” of combining *Mitchell* with *Dionne*, but rather seems to rely on a conjectured assertion that “the references can be combined” without regard to the “desirability of the combination.” Again, with respect to each claim, the Examiner speculates that “[i]t would have been obvious to one of ordinary skill at the time of the invention to modify the system of *Mitchell* to provide the spelling of words in the text, to aid in the editing of recognized text and in the correcting of recognition errors, for the purpose of assisting individuals with visual impairments with editing of text.” (*Office Action*, page 8). However, Applicants demonstrated above with respect to Claims 7-8, 17, 30, and 32-33 that the motivation provided in the *Office Action* seems to rely on a conjectured assertion that “the references can be combined” without regard to the “desirability of the combination.” Additionally, Applicants have shown that one of ordinary skill in the art at the time of Applicants’ invention would not have motivated to modify the display-centered system of *Mitchell* to incorporate the audible speller of *Dionne*. Accordingly, for the same reasons that the proposed *Mitchell-Ball-Dionne-Frulla* combination is improper with regard to Claims 7-8, 17, 30, and 32-33, the proposed *Mitchell-Dionne-Frulla* combination is also improper with respect to Claims 18-29 and 37.

Second, Applicants respectfully submit that a rejection of Applicants’ claims under the proposed *Mitchell-Dionne-Frulla* combination appears to constitute the type of impermissible hindsight reconstruction of Applicants’ claims, using Applicants’ claims as a blueprint, that is specifically prohibited by the M.P.E.P. and governing Federal Circuit cases. Applicants note that with respect to certain independent claims the Examiner relies upon *Mitchell* for disclosure of retrieving a text file, storing an audio file, and storing a file map. The Examiner then relies upon *Dionne* for disclosure of a speller but on *Frulla* for disclosure of a voice command from a user. Even if each of these references disclose what the Examiner purports they disclose (which Applicants do not admit), a rejection of Applicants’ claims under the proposed *Mitchell-Dionne-Frulla* combination can only result from the piecing together of disjointed portions of unrelated references to reconstruct Applicants’ claims. Such a piecemeal rejection of Applicants’ claims fail to give credence to each element of Appellants’ claims and to the overall combination of features recited in the claims. The very fact that three non-analogous references must be compiled and disjointed portions of those references combined to meet the requirements of Applicants’ claim limitations provides further evidence that one of ordinary

skill in the art at the time of Applicants' invention would not have been motivated to make the proposed combination.

Applicants therefore further request that the rejections of the present claims be withdrawn for want of a *prima facie* showing of obviousness as defined by the M.P.E.P. and for the various other reasons described above.

CONCLUSION

Applicants have made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other apparent reasons, Applicants respectfully request full allowance of all pending Claims. If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Jenni R. Moen, Attorney for Applicants, at the Examiner's convenience at (214) 953-6809.

Applicants believe no fee is due. However, should there be a fee discrepancy, the Commissioner is hereby authorized to charge any required fees or credit any overpayments to Deposit Account No. **02-0384** of **Baker Botts L.L.P.**

Respectfully submitted,
BAKER BOTTS L.L.P.
Attorneys for Applicants

A handwritten signature in black ink, appearing to read 'Jenni R. Moen', with a long horizontal flourish extending to the right.

Jenni R. Moen
Reg. No. 52,038

Date: August 21, 2007

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